

REMARKS

The Applicant has now had an opportunity to carefully consider the comments set forth in the Office Action that was mailed on December 11, 2009. The clarity of the Response to Arguments section is noted with appreciation. However, it is believed that the Response to Arguments highlights **clear errors** of the Office Action. Accordingly, all of the rejections are respectfully traversed. Re-examination and reconsideration are respectfully requested.

The Office Action

In the Office Action that was mailed December 11, 2009:

claim 2 was rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,546,385 to Mao et al. ("Mao");

claim 6 was rejected under 35 USC §103(a) as being unpatentable over Mao in view of U.S. Patent No. 5,276,616 to Kuga et al. ("Kuga");

claim 7 was rejected under 35 USC §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0156754 by Ouchi ("Ouchi"), however, this appears to be an error and it appears that the intention was to reject **claim 7** in light of a combination of Mao and Ouchi; and

claim 8 was rejected under 35 USC §103(a) as being unpatentable over Mao, Ouchi and U.S. Patent No. 6,002,798 to Palmer et al. ("Palmer").

The Present Application

Briefly, the present application is directed to systems and methods for automatic and semi-automatic document indexing of scanned documents. They are useful where a large document is scanned to generate an electronic version of the document. For example, a review of the document may indicate that chapter headings in the document are rendered in an 18-point font size at a location that is centered horizontally on a page and is two inches from the top of the page. In that case, **a first sub-section delimiter** may be defined as any text located two inches from the top of a page and rendered in 18-point font size. Subheadings in the exemplary document might occur anywhere on a page but are rendered in a 16-point font size with underlined characters. Therefore, **a**

second sub-section delimiter for the document might be defined as underlined 16-point text.

Once one or more sub-section delimiters are defined (e.g., by a document processor user), the electronic version of the document is searched to find occurrences of text corresponding to the sub-section delimiters. Information regarding each occurrence is used to create an index or table of contents for the document.

The Cited Documents

In stark contrast, the primary reference of the Office Action to Mao discusses a method and apparatus for indexing and searching content in a hardcopy document that uses a search assistant computing device with an index table stored in memory. **The index table is "created" in memory by scanning a 2-D barcode** from a hardcopy document **or alternatively by downloading indexing information from a web page** via the Internet (**ABSTRACT**).

As such, it is respectfully submitted that Mao does not anticipate a method operative to automatically **generate** an index for a document. Mao simply accesses an existing index.

The Office Action characterizes the search results of Mao as an index. However, such a characterization is clearly based on **impermissible hindsight reasoning**. Furthermore, the search results of Mao are not of a scanned document. Therefore, aspects of the claims are not met by Mao.

Kuga allegedly discloses a system for creating an index of textual data. In the system, a dictionary stores sets of specialized words particular to a field of knowledge related to the textual data. An entry selecting module selects as index entries only those strings which match one of those specialized words and notes the locations of each occurrence of each index entry in the text. A printer outputs the selected index entries together with their occurrence positions (**ABSTRACT**).

Ouchi allegedly discusses a method and system for extracting a title from a document image. Allegedly, a title is determined from a document image of an unspecified format based upon likelihood of containing a title in each of minimal circumscribing rectangles. The likelihood is determined based upon information

obtained during character recognition of the image contained in the minimal circumscribing rectangles (**ABSTRACT**).

Palmer allegedly discloses a method and apparatus for storing document images, for creating retrieval index by which the document images may be retrieved, and for displaying the retrieved document images. When a document image is obtained, the document image is subjected to rule-based block selection techniques whereby individual regions within the document region are identified, and types of regions are also identified, such as title-type regions, text-type regions, line art-type regions, halftone-type regions and color image-type regions. The identification is used to create structural information and both the document image and the structural information is stored. Allegedly, a word-based retrieval index is created based on title-type regions and/or text-type regions (**ABSTRACT**).

The Response to Arguments Section Highlights Clear Errors of the Office Action

The first substantive paragraph in the Response to Arguments (spanning pages 6 and 7) discusses the Office's interpretation of Mao and the interpretation given by the Office to the word --index--. For example, the Response to Arguments asserts that, "although the Applicant appears to disagree with this interpretation of 'index,' the Examiner believes that this interpretation is in accordance with the commonly known definition of 'index.'" The interpretation of the Examiner being referred to is that, "the list of found items or search results are considered to be an index, and therefore, the prior art (meaning Mao) teaches generating an index."

It is respectfully submitted that these statements highlight three **clear errors** of the Office Action.

1. **Mao** uses the term --index-- in a manner that clearly refers to something other than the search results. Accordingly, the interpretation of the Examiner that the search results are the index of Mao is clearly inappropriate. For example, the Abstract of Mao describes a method and apparatus for indexing and searching content **in a hardcopy document** utilizing a search assistant computing device with an index table stored in memory. The **index table** is created in memory by scanning a 2-D barcode from a hardcopy document or alternatively by downloading index information from a webpage

via the internet. A search engine in the search assistant searches the index table to locate a data element found in the content of the hardcopy document. The indexing information corresponding to the data element is displayed to the user as part of the search results to indicate the location of the data element in the hardcopy document. Accordingly, **Mao** considers search results to be search results and **not** to be an index. Accordingly, there is no motivation in the art to interpret or consider the search results of Mao to be an index.

2. Accordingly, the Office Action is based on **impermissible hindsight reasoning** based on information gleaned only from the present application. It is respectfully submitted that nothing else would motivate one to interpret the search results of Mao to be an index when Mao clearly considers search results to be search results and something separate from an index.

3. **Even if the search results of Mao are considered to be an index**, the search results of Mao are not generated in the manner recited in claim 2 of the present application. As made clear by the Abstract of Mao, the search results, which the Office considers to be an index, are generated by searching an index table and not by scanning a printed version of the document to generate scan data, performing optical character recognition functions on the scan data to generate an electronic version of the document, searching the electronic version of the document for one of characters and objects corresponding to the defined subsection delimiter, and generating the index for the document with all found items corresponding to the subsection delimiter occurrences.

Accordingly, even if the interpretation of the Office of search results as being an index, the rejection of **claim 2** is based on **clear error**.

Additionally, the next paragraph of the Response to Arguments appears to address arguments related to **claim 6**. Accordingly, additional **clear errors** of the Office Action are highlighted by the lack of responsiveness of the Office Action to additional arguments made by the Applicant in support of **claim 2**.

This lack of responsiveness is in and of itself a **clear error** of the Office Action. Additionally, it is respectfully submitted that the points which were overlooked by the Response to Arguments each highlight a **clear error** of the Office Action.

1) For example, on page 4 of Applicant's Response O, the Applicant points out that the MPEP at §2131 indicates that, "to anticipate a claim, the reference must teach every element of the claim." Moreover, "the identical invention must be shown in as complete detail as contained in the...claim." It is respectfully submitted that by its use of an index table created in memory by scanning a 2-D barcode from a hardcopy of a document or alternatively by downloading indexing information from a webpage via the internet, Mao clearly does not disclose the identical invention as that disclosed and claimed in the present application. Accordingly, the rejection of **claim 2** is based on **clear error**.

2) On page of 5 of Applicant's Response O, the Applicant points out that the mere indication that the device of Mao may include an optical scanner and an optical character recognition module for optically scanning text and/or data elements from a hardcopy document **does not disclose or suggest** doing so is part of a method to automatically generate an index and that accordingly, Mao **does not disclose** the elements of **claim 2** as arranged as required by the claim and that therefore accordingly, **claim 2** is not anticipated by Mao.

The Response to Arguments does not take note of or respond to this traversal of the rejection of claim 2. It is respectfully submitted that the rejection itself based on the inclusion of hardware but not on the disclosure of a method corresponding to the method recited in **claim 2** represents a **clear error** of the Office Action, and the failure to respond to that traversal represents yet another **clear error** of the Office Action.

3) The present Office Action does not take note of the Applicant's argument that Mao discloses searching a pre-existing index table and **not** "searching the electronic version of the document for one of characters and objects corresponding to the defined sub-section delimiter", as is recited in **claim 2.** The document in Mao is a hardcopy that is not scanned. Mao searches an index which is accessed via a barcode or downloaded from the internet (Abstract). Accordingly, it is not generated by scanning a printed version of the document and performing optical character recognition functions on the generated scanned data. Therefore, searching the index of Mao does not qualify as searching "the electronic version of the document", and again, Mao does not disclose the elements of **claim 2** arranged as required by the claim. Accordingly,

claim 2 is not anticipated by Mao, the rejection of **claim 2** is based on clear error, and the failure of the present Office Action to take note of this argument and respond to the substance of it represents an additional clear error.

The first paragraph in the second half of page 7 of the Office Action appears to address one of the arguments of the Applicant submitted in support of **claim 6**.

However, the Response to Arguments fails to address the argument presented at the bottom of page 6 of Applicant's Response O that the Office has not met its burden of presenting a *prima facie* case of obviousness. Accordingly, the present Office Action includes a clear error

Additionally, with regard to **claim 6**, the Office Action continues to interpret the search results of Mao as an index. At the same time, the Office Action relies on Kuga for disclosing checking that the displayed index is correct and correcting the index.

However, while Kuga depicts an element labeled --index editor--, Kuga **does not disclose or suggest** editing search results. Since the user of Mao relies on the search assistant to provide correct search results, the user of Mao would have no basis for determining that the search results are incorrect, and since the index of Mao is generated by scanning a 2-D barcode or by downloading an index from the internet, the user of Mao would have no ability to correct that index or search results. **It would not be obvious to modify Mao** to provide a mechanism for editing search results, and again, the rejection of **claim 6** is based on clear error.

At the bottom of page 7 and top of page 8 of the present Office Action, the Response to Arguments appears to address arguments presented by the Applicant in support of **claim 7**.

However, the Response to Arguments only addresses one of the arguments and mischaracterizes that argument is so doing.

Included in the arguments in support of **claim 7** that are overlooked by the Response to Arguments are that

1) while the Office Action cites column 7, lines 10-16, for support of the assertion that Mao discloses a user indicating at least a text string, **claim 7 does not recite a user indicating a text string**. Instead, **claim 7** recites selecting an exemplary sub-section title (e.g., as with a computer mouse), performing one of document recognition and optical

character recognition on the selected exemplary sub-section title to determine at least one recognized property (e.g., position of text, font size, font type, etc.) and using the at least one recognized property of the exemplary sub-section title as a sub-section delimiter definition. The Office Action relies on Mao for this disclosure and Mao simply **does not disclose or suggest**, and since the document in Mao is a hardcopy and cannot be displayed to the user for such a selection, **cannot disclose or suggest** this subject matter for which it is relied. Accordingly, the rejection of **claim 7** is based on **clear error**.

The Office Action characterizes the Applicant's argument with regard to Ouchi as, "Applicant submits that Ouchi does not disclose or suggest using the title as a delimiter or using characteristics of a selected title as delimiter characteristics."

2) However, that is not what the Applicant submits. Instead, at the top of page 8 of Applicant's Response O, the Applicant pointed out that even the Office Action did not assert that Ouchi discloses selecting an exemplary sub-section title, performing one of document recognition and optical character recognition on the selected exemplary sub-section title to determine at least one recognized property and using the at least one recognized property of the exemplary sub-section title as a sub-section delimiter definition. This is what **claim 7** recites. **Claim 7** does not merely recite, "using the title as a delimiter or using characteristics of a selected title as delimiter characteristics". Since the Office Action did not assert that Ouchi or Mao discloses these particular details, it appears that the Office recognizes that the cited documents do not disclose or suggest the particular details recited in **claim 7**. Accordingly, it is respectfully submitted that the rejection of **claim 7** is based on **clear error**.

3) Additionally, at the bottom of page 8 of Applicant's Response O, the Applicant pointed out that the index of Mao is fully functional and requires no assistance from Ouchi. Accordingly, the Applicant asserted that the only motivation to combine subject matter from Ouchi with subject matter from Mao is information gleaned only from the present application. The present Office Action does not respond to the substance of these remarks but simply asserts that the Examiner believes there is motivation to combine the two prior art. Accordingly, again, it is respectfully submitted that the present Office Action includes, and the rejection of **claim 7** is based on, **clear error**.

On page 8 of the Office Action, the Response to Arguments mischaracterizes Applicant's arguments with regard to **claim 8**. In this regard, the Response to Arguments asserts that, "The Applicant submits that the cited portions of Mao and Ouchi are directed toward discussion of displaying documents or portions of documents."

However, the arguments presented on, for example, pages 9 and 10 of Applicant's Response O imply exactly the opposite by pointing out that the Office Action stipulates that Mao, as modified by Ouchi, fails to disclose displaying a plurality of documents on a user interface, selecting at least one demarcation point on at least one of the plurality of pages and using the at least one demarcation point as the defined sub-section delimiter.

The Response to Arguments indicates that, "first of all, the Examiner would like to note that the teachings of demarcation point and displaying a plurality of pages is taught by Palmer", as if the Office believes the Applicant misunderstood this point.

However, it is noted that the Applicant is fully aware that this is the position of the Office and so noted on page 9 of Applicant's Response O where the Applicant notes that, "in this regard, the Office Action cites column 8, lines 9-10, and lines 25-45 of Palmer."

Next, the Response to Arguments contradicts itself by asserting that, "the claimed recitation regarding making a selection on at least one of pages on the document is taught by Mao and Ouchi. Mao, as modified by Ouchi, already teaches the user inputs a search term and the search term results is displayed."

Accordingly, it appears that the Office Action is now stipulating that Palmer does not disclose --selecting at least one demarcation point on at least one of the plurality of pages--, as is recited in **claim 8** and is now relying on Mao and Ouchi for this disclosure. **However**, then the Response to Arguments discusses Mao, as modified by Ouchi, allegedly teaching the user inputs a search term and the search results is displayed. However, **claim 8** does not recite inputting a search term. **Claim 8** recites selecting (e.g., as with a computer mouse) at least one demarcation point on at least one of the displayed plurality of pages. It is respectfully submitted that even if Mao, as modified by Ouchi, disclosed a user inputting a search term, **that would not disclose**

or suggest selecting a demarcation point on at least one of the plurality of pages displayed on a user interface.

Accordingly, it is respectfully submitted that the rejection of **claim 8** is based on **clear error**.

Additionally, page 8 of the present Office Action contradicts itself again by asserting that, "the Examiner understands that Mao and Ouchi do not explicitly teach a demarcation point and displaying a plurality of pages."

At this point, rather than responding to the argument on page 9 that the cited portions of Palmer are directed toward discussion of displaying documents or portions of documents and are completely unrelated to making a selection of a demarcation point on at least one of the plurality of display pages, the Response to Arguments simply asserts that Palmer discloses a plurality of document pages are displayed and the operator can select whether to display the text characters of OCR processed text regions or document pages of text regions and further, the operator may select the abstraction level.

It is respectfully submitted that this is not a response to the substance of the Applicant's argument. Only impermissible hindsight reasoning would lead one to interpret this aspect of Palmer as teaching selecting a demarcation point on at least one of the plurality of pages, as is recited in **claim 8** of the present application. The cited portions of Palmer are completely unrelated to using at least one demarcation point as a defined sub-section delimiter for generating an index. Selecting an abstraction level at which a structural view is displayed as is discussed in Palmer is not a designation of a demarcation point for the purpose of generating an index as is recited in the combination of **claims 7 and 8** of the present application.

There is no motivation in the art other than that found in the present application to provide a means for designating a sub-section delimiter by selecting demarcation points on a plurality of pages displayed on a user interface. It is respectfully submitted that the combination of Mao, Ouchi and Palmer is forced and unnatural and can be motivated only by **impermissible hindsight reasoning**. Accordingly, the rejection of **claim 8** is based on **clear error** and reconsideration is respectfully requested.

The Claims Are Not Anticipated

Claim 2 was rejected under 35 USC §102(e) as being anticipated by Mao.

In this regard, the Office is reminded that to anticipate a claim, the reference must teach every element of the claim. Moreover, "the identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990). (MPEP §2131)

Claim 2 recites a method operative to automatically generate an index for a document that involves scanning a printed version of a document and performing optical character recognition functions on the electronic version of the document. The Office Action points to hardware in the system of Mao that could be used in such a process. **However, Mao does not disclose or suggest** that the equipment be used in a method for generating an index. That idea is gleaned only from the present application and the Office is applying **impermissible hindsight reasoning**. Accordingly, the Office has not met its burden of presenting a *prima facie* case of anticipation and **claim 2** is not anticipated by Mao.

With regard to the first element recited in **claim 2** (determining a subsection delimiter definition including at least one delimiter characteristic), the Office Action appears to cite column 7, lines 10-16, of Mao.

However, the cited paragraph (beginning at line 6) indicates that the searching assistant of Mao can be utilized to assist a reader of a hard copy document to search efficiently the hard copy document via indexing information stored in the indexing tables 420 and the memory 412 [of the searching assistant 402]. Accordingly, the cited portion is not directed toward generating an index. Instead, the cited portion discusses using an already existing index. The index of Mao is not generated by scanning and optical character recognition and does not itself qualify as the document recited in **claim 2**. Moreover, the search results do not act as an index into the index and again, the index of Mao does not qualify as the document recited in **claim 2**.

The cited paragraph goes on to indicate that at steps 702 and 704, the searching assistant verifies whether the user is requesting a manual entry for search words or

query words to index into the document. If the user, at step 704, enters certain query words or search words for indexing, then at step 706 the searching assistant 402 accepts the query words from manual entry via the user input 422 and then at step 708, the searching assistant 402 searches with the searching engine 410 to find the particular index entries in the index table at step 708.

Again, clearly, the cited portion is directed toward using an existing index and **does not disclose steps or processes** associated with a method for **generating** an index.

Accordingly, Mao does not disclose the elements arranged as required by the claim and the rejection of **claim 2** is based on clear error and **claim 2** is not anticipated by Mao.

With regard to the recitation of scanning a printed version of the document to generate scan data and performing optical character recognition functions on the scan data to generate an electronic version of the document, the Office Action cites column 5, lines 38-41, of Mao.

However, **the mere** indication that a device may **include** an optical scanner and an optical character recognition module for optically scanning text and/or data elements from a hardcopy document **does not disclose or suggest** doing so as part of a method to automatically **generate** an index. Accordingly, again, Mao does not disclose the elements of **claim 2** arranged as required by the claim. Accordingly, the rejection of **claim 2** is based on clear error and **claim 2** is not anticipated by Mao.

With regard to the recitation in **claim 2** of searching the electronic version of the document for one of characters and objects corresponding to the defined subsection delimiter, the Office Action cites column 7, lines 16-17.

However, as indicated above, the cited portion discusses the searching assistant 402 searching with the search engine 410 to find the particular index entries in the index table 420. Accordingly, Mao does not disclose searching the electronic version of the document. The cited portion discusses searching an already existing index. Accordingly, the Office has not met its burden of presenting a *prima facie* case of anticipation. Therefore, the rejection of **claim 2** is based on clear error and **claim 2** is not anticipated by Mao.

With regard to the recitation in **claim 2** of generating the index for the document with all found items corresponding to the subsection delimiter occurrence, the Office Action cites column 7, lines 18-21.

However, the cited portion recites --then, at step 710, the searching assistant 402 displays a result of the search to the user [i.e., the search of the index entries in the index table], at step 710, and then exits the searching operation at step 712.-- It is respectfully submitted that the Office recognizes that this display of search results from a search of an **already existing index** does not disclose or suggest **generating an index** for the document with found items corresponding to the subsection delimiter occurrences as recited in **claim 2**. Accordingly, the Office asserts that --such displaying action of the search "is considered" as generating an index for the document with all found items corresponding to the subsection delimiter occurrences because the invention displays a customized index geared toward a particular user--. Clearly, such search results are not an index. Clearly, such search results do not represent disclosure of **generating** an index. The display of search results are a display of entries in an existing index and are not an index of the index of Mao but are search results related to a separate hardcopy document.

For at least the foregoing reasons, the rejection of **claim 2** is based on **clear error** and **claim 2** is not anticipated by Mao.

The Claims Are Not Obvious

Claim 6 was rejected under 35 USC §103(a) as being unpatentable over Mao in view of Kuga. In an effort to support this rejection, the Office Action simply asserts that Mao discloses displaying the created index and checking that the displayed index is correct without citation to any portion of Mao allegedly disclosing such subject matter. Accordingly, **the Office has not met its burden** of presenting a *prima facie* case of obviousness. Additionally, it is respectfully submitted that Mao **does not disclose or suggest** displaying an index. Moreover, it is respectfully submitted that Mao does not disclose or suggest checking that the displayed index is correct. Mao discusses displaying search results and does not suggest a need to check or correct those search results.

Additionally, the Office Action stipulates that Mao fails to disclose correcting the index.

In this regard, the Office Action relies on Kuga.

However, even if Kuga could be construed as disclosing correcting an index, **claim 6** depends from **claim 2** and is not anticipated and is not obvious for at least that reason. Additionally, the assertions of the Office Action that Mao discloses displaying an index and checking that the displayed index is correct are unsubstantiated and unsupported.

For at least the foregoing reasons, the rejection of **claim 6** is based on clear error and **claim 6** is not anticipated and is not obvious in light of Mao and Kuga.

Claim 7 was rejected under 35 USC §103(a) as being unpatentable over Mao and Ouchi.

However, in explaining this rejection, the Office Action ignores most of the recitation found in **claim 7**. For example, **claim 7** recites *inter alia*: a method operative to automatically generate an index for a document, the method comprising: determining a sub-section delimiter definition including at least one delimiter characteristic, wherein determining a sub-section delimiter definition comprises selecting an exemplary sub-section title, performing one of document recognition and optical character recognition on the selected exemplary sub-section title to determine at least one recognized property, and using the at least one recognized property of the exemplary sub-section title as a sub-section delimiter definition.

In regard to determining a sub-section delimiter definition, the Office Action cites column 7, lines 10-16, and characterizes the cited portion as "disclosing and determining a sub-section delimiter definition including at least one delimiter characteristics, wherein determining a sub-section delimiter comprises a user indicating at least a text string."

However, **claim 7** does not recite a user indicating a text string. **Claim 7** recites selecting an exemplary sub-section title and performing document recognition or optical recognition on the selected exemplary sub-section title.

Further in this regard, the Office Action stipulates that Mao fails to disclose the sub-section delimiter is a title and relies on Ouchi for this disclosure.

However, even in the assertions of the Office Action regarding Ouchi, there is no assertion that Ouchi discloses selecting an exemplary sub-section title, performing one of document recognition and optical character recognition on the selected exemplary sub-section title to determine at least one recognized property and using the at least one recognized property of the exemplary sub-section title as a sub-section delimiter definition. Instead, the Office Action merely asserts that Ouchi discloses extracting a title and that title extraction software is initiated by a user. Ouchi **does not disclose or suggest** using the title as a delimiter or using characteristics of a selected title as delimiter characteristics. Instead, the software of Ouchi searches for titles according to its own rules.

In any event, Mao **does not disclose or suggest** the other elements of **claim 7** for which it is relied. The Office Action asserts that Mao discloses searching the electronic version of the document for one or more of the characters and objects corresponding to the defined sub-section delimiter and cites column 7, lines 16-17, in this regard.

However, as indicated above, the cited portion describes searching an already existing index and does not disclose or suggest a method for generating an index that involves searching an electronic version of a document for characters or objects corresponding to a defined sub-section delimiter. The searching assistant of Mao displays the results of the search of the already existing index. The Office Action considers this generating an index. However, displaying found items in an index **does not disclose generating** an index from all found items corresponding to sub-section delimiter occurrences.

For at least the foregoing reasons, the rejection of **claim 7** is based on **clear error** and **claim 7** is not anticipated and is not obvious in light of Mao and Ouchi.

Additionally, there is no motivation in the art to combine subject matter from Ouchi with subject matter from Mao. The index of Mao is fully functional and requires no assistance from Ouchi. Accordingly, the only motivation to combine subject matter from Ouchi with subject matter from Mao is information gleaned only from the present application. Accordingly, the rejection of **claim 7** is based on **impermissible hindsight** reasoning.

For at least the foregoing additional reasons, the rejection of **claim 7** is based on **clear error** and **claim 7** is not anticipated and is not obvious in light of Mao and Ouchi.

Claim 8 was rejected under 35 USC §103(a) as being unpatentable in view of three documents including Mao, Ouchi and Palmer.

However, **claim 8** depends from **claim 7** and is not anticipated and is not obvious for at least that reason. Additionally, the Office Action stipulates that Mao as modified by Ouchi fails to disclose displaying a plurality of document pages on a user interface, selecting at least one demarcation point on at least one of the plurality of pages and using the at least one demarcation point as the defined sub-section delimiter. In other words, the Office Action stipulates that Mao and Ouchi fail to disclose the entire subject matter of claim 8. In this regard, the Office Action cites column 8, lines 9-10, and lines 25-45 of Palmer.

However, the cited portions are directed toward discussion of displaying documents or portions of documents and are completely unrelated to making a selection of a demarcation point on at least one of a plurality of displayed pages. Moreover, the cited portions of Palmer are completely unrelated to using the at least one demarcation point so selected **as a defined sub-section delimiter** for **generating an index** for a document as recited in **claim 7**. In this regard, the Office Action attempts to cast the discussion of an operator selecting an abstraction level at which a structural view is displayed as a designation of a demarcation point.

However, a demarcation point is a point and the demarcation point referred to in **claim 8** is **on** at least one of the plurality of pages. It is respectfully submitted that, even if the designation of various abstraction levels could be construed to be a demarcation point, Palmer **does not disclose** using the selected abstraction level as a sub-section delimiter to generate an index for a document with found items corresponding to occurrences of the sub-section delimiter.

For at least the foregoing reasons, the rejection of **claim 8** is based on **clear error** and **claim 8** is not anticipated and is not obvious in light of Mao, Ouchi and Palmer.

Furthermore, there is no motivation in the art to combine subject matter from Palmer with Mao and Ouchi. The motivation suggested by the Office Action is

specious. The Office Action suggests a motivation for making the combination is --if the user decides to change the display or section of the document to be displayed, the user can easily switch over to another section without modification to the program--.

However, Mao is not concerned with displaying a document. According to Mao, the document is in hardcopy form (e.g., Abstract, line 2, 5 and 13). The invention of Mao relates in general to methods for indexing and searching hardcopy documents, and more particularly, to a method and apparatus for electronically indexing data elements in a hardcopy book or document and thereby searching and locating a particular data element in the hardcopy book or document (column 1, lines 5-14). Accordingly, there is no motivation to modify Mao to change the display or section of a document to be displayed.

For at least the foregoing additional reasons, the rejection of **claim 8** is based on clear error and **claim 8** is not anticipated and is not obvious in light of Mao, Ouchi and Palmer.

Telephone Interview

In the interests of advancing this application to issue the Examiner is invited to telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.

CONCLUSION

Claims 2, 6, 7 and 8 remain in the application. For at least the foregoing reasons, the application is in condition for allowance. Accordingly, an early indication thereof is respectfully requested.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	4	- 29 =	0
INDEPENDENT CLAIMS	2	- 8 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Thomas Tillander, at Telephone Number (216) 363-9000.

Respectfully submitted,

Fay Sharpe LLP

2/10/09
Date

Patrick R. Roche
Patrick R. Roche, Reg. No. 29,580
Thomas Tillander, Reg. No. 47,334
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, OH 44115
Phone: (216)363-9000
Fax: (216)363-9001

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